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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,711	12/10/2003	Shaoning Jiang	15769RRUS02U	2053

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SLATER & MATSIL, L.L.P.
17950 PRESTON RD, SUITE 1000
DALLAS, TX 75252-5793

EXAMINER	
EKONG, EMEM	
ART UNIT	**PAPER NUMBER**
2617	

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/732,711	JIANG ET AL.	
	Examiner	Art Unit	
	EMEM EKONG	2688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10 and 13-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10, & 13-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 01/20/2006 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-9, and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 01/06735 A2 to Chan Hyoung Rhee (Rhee et al) in view of International Publication No. WO 01/86931 A1 to Park.

Regarding claim 1, Rhee et al discloses a method for providing custom ringback in a telecommunications network, the method comprising:

receiving an initiation of a communication between a first party (originating telephone) and a second party (receiving telephone); determining a custom ringback feature associated with either the first party(originating telephone) or the second party (receiving telephone) (see figures 1 and 2, abstract, and page 1 lines 7-27);

Wherein information relating to the custom ringback feature is provided in a standard parameter that includes a number of elements (see figure 1, page 6 line 4-8, page 10 lines 10-12, col. 10 lines 23-col. 11 lines 17, commercial information server), and used to control operations of the telecommunications network (page 2 lines 4-7);

connecting an intelligent peripheral to the first party(originating telephone) and providing a custom ringback to the first party in accordance with a determined custom ringback feature (see figures 1 and 2, page 3 line 10-page 4 line 4, page 10 line 25-page 11 line 10, and page 33 line 7-page 34 line 13); and

attempting to connect the first party (originating telephone) with the second party (receiving telephone) while the first party (originating telephone) is being provided the custom ringback (page 4 lines 4-17).

However, Rhee et al. fails to disclose the elements including a plurality of elements defined by a industry standard.

Park discloses the elements including a plurality of elements defined by a industry standard (page 9 lines 5-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Rhee et al. and have the elements including a plurality of elements defined by a industry standard as disclosed by park for the purpose of using elements for advertisements during call connection.

Regarding claim 2, the combination of Rhee et al. and Park discloses the method of claim 1 and further comprising contacting a service control point to determine if either the first party (originating telephone) or the second party (receiving telephone) has subscribed to a custom ringback service (Rhee et al., page 6 lines 24-28, and page 33 line 7 – page 34 line 8).

Regarding claim 3, the combination of Rhee et al. and Park discloses the method of claim 2 wherein determining whether either the first party (originating telephone) or the second party (receiving telephone) has subscribed to a custom ringback service comprises receiving a service flag from a home location register (Rhee et al., page 6 lines 24-28, and page 33 line 7 – page 34 line 8).

Regarding claim 4, the combination of Rhee et al. and Park discloses the method of claim 3 wherein the second party is a wireless telephone subscriber such that determining whether either the first party (originating telephone) or the second party (receiving telephone) has subscribed to a custom ringback service comprises determining that the second party (receiving telephone) has subscribed to a custom ringback service (Rhee et al., page 10 lines 12-15).

Regarding claim 5, the combination of Rhee et al. and Park discloses the method of claim 1 wherein at least one of the parties is wirelessly connected to the other party to the call (Rhee et al., page 10 lines 12-14).

Regarding claims 6, 7, 8, the combination of Rhee et al. and Park discloses the method of claim 1 wherein the custom ringback comprises a music clip (reads on claim 6), a video clip (reads on claim 7), and a multimedia content (reads on claim 8) (Rhee et al., page 3 lines 1-6 and page 6 lines 5-8).

Regarding claim 9, Rhee et al. discloses the method of claim 1 and further comprising connecting the first party (originating telephone) with the second party (receiving telephone) (see figure 1).

However, Rhee et al. fails to disclose wherein the custom ringback continues after the first party is connected with the second party.

Park discloses wherein the custom ringback continues after the first party (sender terminal) is connected with the second party (receiver terminal) (page 18 line 3 – page 19 line 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Rhee et al. with the teachings of Park for the purpose of continuing with ringback such as an ad user information after the first party is connected to the second party.

Regarding claim 17, Rhee et al. discloses a telecommunications system comprising: a service control point storing information indicating how a telephone call should be handled, the information including information related to a custom ringback service (page 33 line 6 –page 34 line 14);

an intelligent peripheral having access to at least one custom ringback clip; and at least one switch communicatively coupled to the service control point and to the intelligent peripheral (page 36 lines 8 – page 37 line 15),

the at least one switch configured to route the at least one custom ringback clip from the intelligent peripheral to a caller based upon the information related to a custom ringback service stored in the service control point (see figures 1, 16 and 17, page 33 line 9- page 34 line 14),

wherein the service control point is configured to communicate with the at least one a switch, at least one of the responses including a parameter with a plurality of elements, the parameter being transmitted from the service control point to the at least one switch to indicate where to route the telephone call, wherein one of the elements of the parameter provides the information related to the custom ringback service (see figure 1, page 6 line 4-8, 24-28, col. 10 lines 23-col. 11 lines 17, col. 14 lines 19-28)

However, **Rhee et al. fails to disclose** a plurality of industry standard responses.

Park discloses a plurality of industry standard responses (page 9 lines 5-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Rhee et al. by having a plurality of industry standard responses as disclosed by Pack for the purpose of providing advertisements during call connection.

Regarding claim 18, the combination of Rhee et al. and Park discloses the system of claim 17 and further comprising a home location register (commercial information server) communicatively coupled to the at least one switch (Rhee et al., see figure 1).

Regarding claim 19, the combination of Rhee et al. and Park discloses the system of claim 17 wherein the telecommunications network comprises a network with a wireless air interface (Rhee et al., page 10 lines 12-14).

Regarding claim 20, the combination of Rhee et al. and Park discloses the system of claim 19 wherein the telecommunications network comprises a wireless GSM network (Rhee et al., page 5 lines 23-28).

Regarding claim 21, the combination of Rhee et al. and Park discloses the system of claim 17 wherein the custom ringback clip comprises an audio clip (Rhee et al., page 3 lines 1-5).

Regarding claim 22, the combination of Rhee et al. and Park discloses the system of claim 17 wherein the custom ringback clip comprises a video clip (Rhee et al., page 3 lines 1-4).

6. Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhee et al. in view of U. S. Patent No. 6122510 to Granberg.

Regarding claim 10, Rhee et al discloses a method of providing a custom ringback service, the method comprising (page 1 lines 7-21):

receiving a call indication from a caller that is directed to a wireless telephone subscriber (page 1 line 26- page 2 line 23, and page 10 lines 5-27);

performing a look-up to a home location register (commercial information server) (see figures 1 and 2, page 6 line 24-28, page 10 line 15 – page 11 line 10, page 12 lines 1-4, and page 33 line 17 – page 34 line 8);

receiving a service flag from the home location register, the service flag (page 6 line 24-28, and page 33 line 17 – page 34 line 8) indicating that the wireless subscriber subscribes to a custom ringback service;

providing information related to the service flag to a service control point (page 10 line 12-15);

receiving ringback routing information from the service control point (see figure 17, page 14 line 24 –page 9, and page 33 line 9- page 34 line 14);

initiating a connection between an intelligent peripheral and the caller, the connection being related to the ringback routing information such that a custom

ringback is played to the caller; and attempting to connect the caller to the wireless subscriber (see figures 1,2,16 and 17, page 12 lines 1-19, and page 34 lines 9-13).

However, **Rhee et al.** fails to disclose wherein receiving ringback routing information comprises receiving a CONNECT message and wherein the ringback routing information is embedded in a generic parameter.

Granberg discloses wherein receiving routing information comprises receiving a CONNECT message and wherein the routing information is embedded in a generic parameter (col. 8 line 44-col. 9 line 6, SCF sends routing information to the MSC/VLR/SSF in an INAP/CAP connect message).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of **Rhee et al.**, and have the ringback routing information comprises receiving a CONNECT message and wherein the ringback routing information is embedded in a generic parameter as disclosed by **Granberg** for the purpose of call routing.

7. **Claims 13 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhee et al. in view of Granberg and further in view of U.S Patent No. 5,926,537 to Michael J Birze (Birze).

Regarding claim 13, the combination of Rhee et al and Granberg discloses the method of claim 10.

However, the combination fails to disclose wherein initiating a connection between an intelligent peripheral and the call comprises: routing a call to the intelligent

peripheral using an ISUP message; receiving an assist request instruction from the intelligent peripheral; sending a play announcement message to the intelligent peripheral; receiving an address complete message from the intelligent peripheral.

Brize discloses the method wherein initiating a connection between an intelligent peripheral and the call comprises (see figure 1):

routing a call to the intelligent peripheral using an ISUP message (col. 3 lines 45-54);

receiving an assist request instruction from the intelligent peripheral (terminating telecommunications exchange) (col. 3 lines 55- 57);

sending a play announcement message to the intelligent peripheral (terminating telecommunications exchange) (col. 3 lines 66 - col. 4 line 2;

receiving an address complete message from the intelligent peripheral (terminating telecommunications exchange) (col. 3 lines 66 - col. 4 line 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination with the teachings of Brize for the purpose of using a call setup signal such as ISUP.

Regarding claim 16, the combination of Rhee et al and Granberg discloses the method of claim 10, however, the combination fails to disclose further comprising waiting a delay time before attempting to connect the caller to the wireless subscriber.

Brize discloses the method comprising waiting a delay time before attempting to connect the caller to the wireless subscriber (col. 2 line 63 – col. 3 line 1, and col. 6 lines 17-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination with the teachings of Brize for the purpose of allowing some time for the calling party to hear the ringback tone.

8. **Claims 14 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhee et al. in view of Granberg, and further in view of Brize as applied to claim 13 above, and further in view of U.S Patent No. 6,023,618 to Risto Janhonen (Janhonen et al.).

Regarding claims 14 and 15, the combination of Rhee et al., Granberg, and Brize discloses the method of claim 13, however, the combination fails to specifically disclose wherein the address complete message comprises an ACM [no In-Band Info; BCI: No Charge] message (claim 14);

the address complete message comprises ACM [no In-Band Info; BCI: No Charge] message followed by an ANM [BCI: No Charge] message (claim 15).

Janhonen et al. discloses the method wherein the address complete message comprises an ACM [no In-Band Info; BCI: No Charge] message (reads on claim 14) (col. 5 line 66 – col. 6 line 19).

the address complete message comprises an ACM [no In-Band Info; BCI: No Charge] message (reads on claim 15) (col. 5 line 66 – col. 6 line 19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination with the teachings of Janhonen et al. for the purpose of using a call setup signal such as ISUP signaling.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMEM EKONG whose telephone number is 571 272 8129. The examiner can normally be reached on 8-5 Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on 571 272 7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EOE
3/20/06

NICK CORSARO
PRIMARY EXAMINER